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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,955	08/27/2003	Bennett M. Richard	D5407-188	4065
25397	7590	05/17/2005	EXAMINER	
DUANE, MORRIS, LLP 3200 SOUTHWEST FREEWAY SUITE 3150 HOUSTON, TX 77027			COLLINS, GIOVANNA M	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/648,955	Applicant(s) RICHARD ET AL.	
	Examiner Giovanna M. Collins	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell 6,112,818.

Campbell discloses (see Fig. 1)) a method of positioning a tubular in a borehole, comprising delivering the tubular (14) into the borehole; positioning the tubular after said delivering in the borehole in a manner that leaves an annular space around it (at 17); and expanding the tubular (col. 2, line 27-col. 3, line 29).

Referring to claims 14, Campbell discloses expanding the tubular with a swage (30).

3. Claims 1 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Chatterji et al. 6,543,545

Chatterji discloses (see Fig. 1)) a method of positioning a tubular in a borehole, comprising delivering the tubular (10) into the borehole; positioning the tubular after

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said delivering in the borehole in a manner that leaves an annular space around it (at 48); and expanding the tubular (Fig. 2).

Referring to claims 15, Campbell discloses expanding the tubular with internal (col. 7, lines 43-46).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5,7-13, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatterji et al. '545 in view of Wilson et al. 5,228,518.

Chatterji discloses the method of claim 1 and discloses the positioning is done by centralizers but does not disclose providing a plurality of openings and disposing an extendable member in each opening. Wilson teaches (fig. 2) centralizers that are extendable members (80) in an opening on a tubular (60). Wilson teaches this type of centralizer will not be damaged during installation because the centralizers are located internally until ready extended to position the tubular (col. 1, line 33-col. 2, line 35). As it would be advantageous to avoid damaging the centralizers during installation, it would be obvious to one of ordinary skill in the art at the invention to modify the method disclosed by Chatterji to have centralizers that are extendable members in openings as taught by Wilson.

Referring to claim 3, Wilson teaches (see Fig. 3) keeping the extendable members substantially within the tubular.

Referring to claim 4, Wilson teaches (see fig. 12) providing a closed end where the closed end is selectively driven toward the borehole wall.

Referring to claim 5, Wilson teaches (see fig. 5) providing a open end where the open end is selectively driven toward the borehole wall.

Referring to claim 7, Chatterji, as modified, does not disclose driving an extendable member prior to expansion. As it would be advantageous to centralize the pipe in the correct position prior to expansion, it would be obvious to one of ordinary skill in the art at the time of the invention to further modify the method disclosed by Chatterji to have the extendable members driven before expansion.

Referring to claim 8, Wilson teaches locking the members against collapse (see Fig. 4, at 132, 142 and 141).

Referring to claims 9-10, Wilson teaches (see fig. 10) providing a open leading end on the extendable member that penetrates the borehole wall.

Referring to claims 11-12 and 20, Wilson teaches using internal pressure (col. 12, lines 68- col. 13 line 6) or mechanical force for driving.

Referring to claim 13, Chatterji, as modified, does not disclose the extendable member extends no further than an upset or coupling at a joint on the tubular prior to extending. However, Wilson teaches the extendable member can be a variety of shapes (col. 5, lines 13). Furthermore, a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ

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237 (CCPA 1955). Therefore it would be obvious to one of ordinary skill in the art to further modify the method disclosed by Chatterji to extend the extendable member no further than an upset or joint because size of a prior art device is a design consideration within the skill of the art.

Referring to claim 18, Chatterji teaches delivering a sealing material under pressure through a tubular to an annular space (col. 5, lines 18-24) and expanding the tubular before the sealing material sets up (col. 6, lines 3-7).

Referring to claim 19, Wilson teaches (see fig. 13) providing an open end and a closed end on at least one of the extendable members.

6. Claims 1,2,4,6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maguire et al.(US 2003/00447322).

Maguire discloses (see Fig. 5) a method of positioning a tubular in a borehole, comprising delivering the tubular (200) into the borehole; and expanding the tubular (at 116). Maguire does not specifically disclose positioning the tubular in the bore after being delivered to the borehole. However, the equipment that delivered the tubular would also position the tubular once it is installed in the borehole to ensure the tubular is not sitting in a cocked position in the bore hole. As it would be advantageous to ensure the tubular is not sitting in a cocked position, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Maguire to correctly position the tubular in the well.

Referring to claim 2, Maguire discloses providing a plurality of openings (at 220) in said tubular; disposing an extendable member (220) in each said opening.

Referring to claim 4, Maguire disclose a closed end on the extendable member (220) that is driven towards the borehole wall.

Referring to claim 6, Maguire discloses driving at least one of said extendable members (220) toward the borehole wall with said expansion.

Referring o claim 9, Maguire discloses penetrating the borehole wall with at least one of said extendable members (220).

Allowable Subject Matter

Claims 16-17 are allowed.

Response to Arguments

7. Applicant's arguments with respect to claims 1-15 and 18 -20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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